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Vedder Price PC
222 NORTH LASALLE STREET
CHICAGO, IL 60601

EXAMINER	
MEHRAVARI, PETER CYRUS	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/598,381	NARESSI ET AL.
	Examiner	Art Unit
	PETER MEHRAVARI	2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 August 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-27 are pending.

Claim Rejections – 35 USC §112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 8, 9-10, 13, 15, 16-17, 19-21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6:

- "the portable media playing device" lacks proper antecedent basis.

- "to commence playing of retrieved additional information associated with the read RFID tag" should instead be "to commence playing of **the** retrieved additional information associated with the read RFID tag" because the retrieved additional information was already introduced in claim 1.

Claim 8:

- It is indefinite how the RFID writer can write information to the portable digital media container, since the portable digital media container is not capable of being written information to by a RFID writer. Instead, it is the RFID tag **located on the** portable digital media container that is the capable of being written to.

Claim 9:

- it is unclear whether the RFID tag or the RFID reader is coupled to a surface of the digital media container. In the furtherance of prosecution Examiner assumes the RFID tag is coupled to the digital media container.

Claim 13:

- “the portable digital media container" lacks proper antecedent basis.

Claim 15:

- “a portable media container” and “the RFID tag on an article” lacks proper antecedent basis, instead, it should be “the portable media container” and “the RFID tag on the object” as first introduced in claim 12.

Claim 16:

-“the read content ID” lacks proper antecedent basis, instead, it should be "the read **remote** content ID data"

- “the content ID” lacks proper antecedent basis.

- “content ID data" is indefinite because it is not properly distinguishable from the "remote content ID data", the "read content ID data" or "the sent content ID"

Claim 17:

- “the content ID data” is indefinite because as discussed above in claim 16, it is unclear which content ID data this is referring to.

- it is unclear how the limitation “securely accessing an online service” has to do with the other steps in the method because there are no connecting words or descriptions that give this limitation any context.

Claim 19:

- It is unclear whether "the content" and "downloadable content associated with the RFID tag" are the same content since "the content" seems to be downloaded and associated with the RFID tag also.

Claim 21:

- "if authentication was successful" is indefinite because there is neither a first recitation of an authentication being conducted nor is there any recitation of what is device or data is being authenticated. While there is a recitation of "sending authentication information" in claim 20, there is no step of actually authenticating and the device receiving the outcome (positive or negative) of the authentication process.

Claim 23:

- It is unclear what the subscription information is associated with. There are too many elements in claim 22 to use the term "therewith" to connect the subscription information to a definite limitation.

Claim Rejections – 35 USC §103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. **Claims 1-8, 9-16, 18-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahlman (US. Pub. No. 2005/0237886) in view of England (US. Pat. No. 7,325,145).**

1) Regarding claim 1, Kahlman teaches a digital media playing system comprising: a portable digital media container **(Fig. 2, No. 1, information carrier, [0030], the information carrier can be a DVD, CD-R, CD, DVD+RW, CI-I and other members of the family of optical information carriers)** having a radio frequency identification (RFID) tag **([0032], the optical information carrier 1 further comprises an integrated circuit, "[t]he chip is, for example, a MiFare RFID chip)**, containing RFID tag information **([0033])**, coupled thereto; and a media playing device having a radio frequency identification tag reader operatively coupled therewith to read information from the RFID tag on the portable media container **([0034], "[t]he chip and the antenna are capable of achieving an electromagnetic coupling to another antenna connected to a read-out IC in a playback appliance; [0042])**. Kahlman then teaches the information on the RFID tag is capable of authenticating the information carrier and or provide extra features to the execution of the media on the information carrier, such as playing a movie, audio or showing an image **([0007]-[0009]; [0033])**. However, Kahlman does not teach how the authentication information on the RFID tag is used to authenticate the information carrier and instead solely focuses on the structure and electrical transmissions from the information carrier to the media playing device.

However, Kahlman lack of teaching does not mean that such methods of authentication were not known. Instead, the failure to go into such methods illustrates that such authentication methods were well known in the art and Kahlman could simply focus on his inventive features. Such methods of authentication are illustrated by England. In England, authentication of an information carrier, specially an optical media container, is performed by analyzing the authentication information on the information carrier on the disk **(Fig. 5)**, transmitting the authentication information over the internet to a remote server which verifies the authentication information **(Fig. 6)** and if the authentication is verified, the media player is allowed to execute the media on the information media container **(Fig. 5)**. Here, the additional information retrieved by England from the remote server is a verification message that indicates to the media player that the information carrier is authorized to launch. When combined with Kahlman , the only difference is that the authentication data is not stored directly on the information carrier, but on the RFID tag attached to the information carrier. Accordingly, Kahlman in view of England make obvious all subject matter in claim 1. It would be obvious for one having ordinary skill in the art at the time of the claimed invention to combine Kahlman with England because Kalhman purpose of having the RFID tag on the CD it to replace the England's storage of the authentication information on the disk itself. Kahlman would then be motivated to use the now more secure authentication information in the same way as in England to continue with the generally known authentication method by verifying the authentication with the manufacturer/distributor's databases.

2) Regarding claim 2, Kahlman teaches the RFID tag information includes at least encrypted RFID tag identification information **([0033])** as well as other information specifically related to enhancing the execution of the media on the information carrier **([0033])**. It would be obvious in view of Kahlman's broad teachings of enhanced features, that the RFID tag on the information carrier could be used to facilitate other enhanced viewing practices already known to one having ordinary skill in the art at the time of the claimed invention. England teaches one such well known feature, the distribution of "bonus" music tracks to the purchasers of music CDs **(col. 8, lines 28-31)**. England teaches such an embodiment coupled with the already taught authentication process. To implement such a method the data now on the RFID tag instead of directly on the Cd must have the encrypted RFID tag information to perform the authentication verification method **(col. 8, lines 34-36)**, plus at least so sort of code/URL link to initiate the retrieval of the bonus content from a remote location **(col. 8, lines 30-34)**. In fact, England specifically teaches order of first authenticating the information carrier and then proceeding with the obtaining of the content information **(col. 8, lines 34-42)**, in this case obtaining the bonus track.

3) Regarding claim 3, Kahlman and England make obvious all subject matter because the transmission of data over the internet, especially audio and video files is broken up into small packets of data and reassembled on the other side when they are received. Such packing is a form of encryption and such unpacking is a form of decryption, and in order to decrypt the receiving party must know the type of encryption

(the encryption/decryption keys) in order to decrypt/unpack and reassemble the data on the receiving end.

4) Regarding claim 4, Kahlman and England make obvious all subject matter of claims 4 because the communication between the media playing device and the remote service is a two way communication **(Figs. 5-6 of England)**.

5) Regarding claim 5, Kahlman and England make obvious at least a portion of the RFID tag information is encrypted **(Kahlman at [0033], the decoding keys, further, it well known that when passcodes are transmitted wirelessly that one having ordinary skill in the art at the time of the claimed invention would be motivated to encode them to prohibit them from being stolen)** and wherein the controller obtains the additional information in a secure manner **(Again, securing the transmission of data over wireless or wired mediums is well known and those transmitting confidential data, authentication data is known confidential data would be motivated to use secured means)**.

6) Regarding claim 6, England teaches the portable media playing device is operative to commence playing of retrieved additional information associated with the read RFID tag information in response to retrieval of the additional information **(col. 8, lines 40-42)**.

7) Regarding claim 7, Kahlman teaches the media player being a DVD player **([0030], it is generally known that DVD players are capable of playing audio CD-roms and are generally known to be installed in a computer having internet access to enact the methods for authentication as taught by England)**.

8) Regarding claims 9, 11, 12, and 19-21 Kahlman in view of England make obvious all subject matter for the same reasoning recited above regarding claim 2. Specifically, the encrypted RFID tag data is the information that identifiers the CD with the verification system on the remote server and the remote content identifier is the information that executes the program to retrieve the bonus track after the CD's authentication has been verified. The bonus track played on the computer or media device is the audio received from the remote location.

9) Regarding claim 10, Kahlman teaches the digital media container being a DVD, CD-R, CD, DVD+RW, CI-I each of these containers comprises at least a label and an optical storage device that can be read by a disk reader **([0030])**. It can also be interpreted as the carrier being the drive itself and that the medium in the disk. Either of these interpretations clearly make obvious the limitations of claim 10.

10) Regarding claim 13, Kahlman in view of England make obvious memory **(England teaches the media playing device is a computer, a computer has a memory)**, operatively coupled to the controller **(England's standard computer inherently has a processor to control the actions of the computer)**, containing at least player ID data **(Computers inherently have a MAC address)**, playlist data **(Kahlman teaches transmitting playlist data – table of contents comprising all titles and artists stored on the information carrier – to the media playing device and therefore the playlist data must at least be stored temporarily on the media playing device [0033])** and received decryption keys associated with the playlist data **(the authentication keys and the playlist data are both sent from the same RFID**

tag on the information carrier to the media player's memory regarding the same data on the information carrier [0033]) and wherein the controller includes a media cryptography engine operative to authenticate at least one of the portable digital media container and the RFID enabled article **(As discussed above regarding England, the media player device having the memory communicates with the remote server to authenticate the RFID enabled article, this is done by the processor in the computer and one having ordinary skill in the art at the time of the claimed invention would recognized the this task could instead be performed by a separate processor's whose only job is to perform this task)**.

11) Regarding claim 14, Kahlman and England make obvious he digital media playing device including a display **(England teaches the digital media playing device being a computer, col. 8, lines 40-42)** and wherein the controller is operative to produce a media player **(computers use media player applications to play media on a computer)** user interface that presents at least data representing: online service content downloaded from an online server based on content identification information obtained from the RFID tag on the portable media container or an RFID tag on the article **(England at col. 8, lines 28-42)**; media content securely downloaded from a remote media source based on the content identification information obtained from the RFID tag on the portable media container or an RFID tag on the article **(England at col. 8, lines 28-42)**; and media player control graphics for providing media player control to control play of the media content downloaded from the remote media source **(computer applications that are media player have controls to control the media played on**

the computer, for example a play/pause button, the media player application is generally performed at least by a GUI).

12) Regarding claim 15, Kahlman in view of England make obvious all subject matter of claim 15. Specifically, the use of advertisement on the labels of an audio CD or case to promote exclusive content including bonus tracks are well known in the art. Examiner has included the cover of George Brassens - Don Juan CD stating on the cover art “Titres Bonus” which means bonus titles in English.

13) Regarding claim 16, Kahlman in view of England make obvious all subject matter for the same reasoning recited above regarding claims 1-3 and 5. Specifically, the DRM is the Server having the verification module in England and the method recited in claim 16 would be obvious to one having ordinary skill in the art at the time of the claimed invention implementing the system and devices taught by the combination of Kahlman in view of England.

14) Regarding claim 18, Kahlman in view of England make obvious all subject matter for the same reasoning recited above regarding claims 1-3 and 5. Specifically, claim 18 simply teaches the setup of a key encryption system implements by Kahlman in view of England. As such, one having ordinary skill in the art at the time of the claimed invention would find all of the limitations obvious to set up such a system especially one to implement the method of verifying media played at a plurality of media players. For example, it would be obvious that at some point the RFID tags on the information carriers would have to be written with the information later read by the media player claimed in claim 1 and related claims. It would be obvious that the media

players are trusted since they have would inherently comprise the software and hardware necessary to not only read the RFID tag on the information carrier and process such data, but also know to go to the remote server to verify the authentication of such received data. It is generally known that registration of a computer's address is performed with an authentication service when future authentication procedures between devices are designed to take place later.

15) Regarding claim 22, Kahlman in view of England make obvious all subject matter of claim 22 for the same reasoning recited above regarding claims 1 and 15.

16) Regarding claims 24, 25, 26 and 27, Kahlman in view of England make obvious all subject matter for the same reasoning recited above regarding claim 2. Specifically, the remotely accessed information is a bonus music track. It is generally well known by one having ordinary skill in the art at the time of the claimed invention that such bonus tracks on DVD or CDs downloaded from a remote server can both either simply the audio file or a music video. In both cases, England express teaches that the content comes from a web-server **(col. 8, lines 28-42)**. A DVD or CD is a three-dimensional article.

6. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahlman (US. Pub. No. 2005/0237886) in view of England (US. Pat. No. 7,325,145) and Ryal (US. Pat. No. 7,038,985).**

1) Regarding claim 8, Kahlman and England make obvious all subject matter of claim 1. This combination teaches one method of media authentication wherein media

cannot be played until authentication data has been verified. The authentication data is read from the RFID tag on the information carrier. This method is part of the overall motivation to protect the exploitation of digital media rights. Ryal teaches an improved method of protecting digital media rights by keeping track of the number of times the media on the information carrier is downloaded. In Ryal, just like Kahlman, the information carrier (a CDROM or DVD) comprises an RFID tag which comprises authentication and other digital media rights **(col. 2, lines 10-14)**. Ryal teaches that when a copy of the information carrier is made, for example by known media players taught by England, the RFID reader that already reads the authentication data on the RFID tag additionally rights to the tag representing that a copy has taken place **(col. 2, lines 12-19)**. This allows the RFID tag comprised within the information carrier to record the number of times the data on the information carrier has been copied and can prevent further copying after a present number of copies. This known improvement would be obvious to combine with Kahlman in view of England because protecting against excessive copying is a known desire (also explicitly taught as a motivation in digital right protection in Ryal col. 1, line 1 - col. 2, line 5). Accordingly, Kahlman in view of England and Ryal make obvious all subject matter in claim 8.

7. **Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahlman (US. Pub. No. 2005/0237886) in view of England (US. Pat. No. 7,325,145) and Saito (US. Pat. No. 6,424,715).**

1) Regarding claim 17, Kahlman in view of England make obvious all subject matter in claim 17 (except for the cache) for the same reasoning recited above regarding claims 1-3 and 5. Neither Kahlman nor England teach using a cache to expedite the authentication process. However, Saito teaches this deficiency. Specifically, Saito teaches using a cache to store previously obtained encryption content so as to not require communication with a remoter server and instead keep the authentication local when authentication is performed a second time **(col. 13, lines 52-61)**. Further, the uses of caches to reduce latency in a network system are well known as are the motivations behind their use. Therefore, one having ordinary skill in the art at the time of the claimed invention would find it obvious to use a cache in combination with Kahlman in view of England to achieve the generally known benefits of a cache in a network environment.

8. **Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahlman (US. Pub. No. 2005/0237886) in view of England (US. Pat. No. 7,325,145) and Yoshino et al. (US. Pub. No. 2005/0144253).**

1) Regarding claim 23, Kahlman in view of England make obvious all subject matter of claim 22. Kahlman and England both teach ways to protect the media rights of digital content. In such an embodiment, it is well known users in the digital content environment may identified as subscribers (as is illustrated by the language used in Yoshino et al.). In terms of Kahlman in view of England, when a user buys an information carrier, for example an audio CD, they subscribe to all rights and obligations

associated with the purchase of such media. Accordingly, the information stored on the RFID tag associated with the information carrier therefore also has information related to the user subscribing to the media and therefore it can be labeled as subscription information.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

1) Fontijn, US. Pub. No. 2006/0047603 (a digital voucher provided with access control information for accessing digital content located on a server of a content provider).

2) Brady et al., US. Pat. No. 6,201,474 (A magnetic tape information storage media includes a cassette housing having one or more spools for holding a length of magnetic tape and an integral radio frequency identification (RFID) transponder to provide functions **including authentication of the media, indexing of information recorded to the media, enablement/disablement of playback of the media, recording of the number of times the media has been played, inventory, and the like**).

3) Diezmann et al., US. Pat. No. 6,044,046 (data carrier in the form of a write-once or rewritable compact disc (CD) includes a circular CD body with an information-

carrying layer and a chip integrated in the CD body, the CD further including at least one CD coupling element for noncontact transfer of data between the chip and a data processing device)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER C. MEHRAVARI whose telephone number is (571)270-1747. The examiner can normally be reached on Monday thru Friday, 8:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Lee can be reached on 571-272-2963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PETER C. MEHRAVARI

Examiner

Art Unit 2612

/PETER C. MEHRAVARI/
Examiner, Art Unit 2612

/BENJAMIN C. LEE/
Supervisory Patent Examiner, Art Unit 2612